FILE COPY

Office-Supreme Court, U.S.
FILED
OCT 23 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1959

NO. 493

ALONZO L. SMITH, *Petitioner*,

v.

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,
Respondent

PETITION FOR WRIT OF CERTIORARI

VINSON, ELKINS, WEEMS
& SEARLS
JOE E. EDWARDS
M. H. GAY
Of Counsel

J. VINCENT MARTIN,
Counsel for Petitioner
Esperson Building
Houston, Texas

Alpha Law Brief Co., 402 M & M Bldg., Houston 2

SUBJECT INDEX

	PAGE
OPINIONS OF THE COURTS BELOW	2
JURISDICTION	2
QUESTIONS PRESENTED	2
THE STATUTE INVOLVED	3
STATEMENT OF THE CASE	4
REASONS FOR GRANTING THE WRIT	6
ARGUMENT	7
POINT 1	7
POINT 2	10
POINT 3	12
CONCLUSION	14
APPENDIX A (Opinion of the United States Court of Appeals	15
APPENDIX B (Judgment of the United States Court of Appeals)	44
APPENDIX C (Opinion of the United States District Court)	45
APPENDIX D (Judgment of the United States District Court)	59
APPENDIX E (Comparison of Misquoted Claim and Correct Claim)	61

LIST OF AUTHORITIES

CASES	PAGE
Eibel Process Co. v. Minnesota and Ontario Paper Co., 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523	6
Grinnell Washing Machine Co. v. Johnson Company (1917), 247 U.S. 426, 38 S.Ct. 547, 62 L.Ed. 1196	6, 12
Hamilton Mfg. Co. v. Illionis Surgical Supply Co. (7 Cir.), 193 F.2d 938	12
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 85 L.Ed. 132	10
Webster Loom Co. v. Higgins, 105 U.S. 580, 26 L.Ed. 1177	6

UNITED STATES CODE

28 U.S.C. 1254 and 2101(c)	2
35 U.S.C. 103	3

IN THE

Supreme Court of the United States

October Term, 1959

NO. _____

ALONZO L. SMITH, *Petitioner*,

v.

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,
Respondent

PETITION FOR WRIT OF CERTIORARI

To The Honorable The Chief Justice and Associated Justices of The Supreme Court of The United States.

Your petitioner, Alonzo L. Smith, prays for a review on a writ of certiorari of a decision of the United States Court of Appeals for the Fifth Circuit in a case entitled, "Paul Glikin, d/b/a Beltone Hearing Center, Defendant-Appellant, v. Alonzo L. Smith, Plaintiff-Appellee."

Opinions of the Courts Below

The opinion of the Court of Appeals is reported in ___ F. 2d ___, 122 USPQ 432. The opinion of the District Court (which was reversed) is reported in 163 F. Supp. 897, 118 USPQ 415.

The opinions are appended hereto, as provided by the Rules of this Court. A certified copy of the record printed for use in the court below, together with the proceedings and opinion in that court, are furnished, together with copies of the record, all in accordance with the Rules of this Court.

Jurisdiction

The judgment of the Court of Appeals was dated and entered on August 6, 1959. A copy thereof is appended hereto.

On September 5, 1959, the Court of Appeals entered an order staying the mandate for a period of sixty days to permit application for certiorari to this Court.

The jurisdiction of this Court is invoked under the Judicial Code, 28 United States Code, Sections 1254 and 2101(c).

Questions Presented

1. Where an individual inventor disclosed his invention to a number of manufacturing corporations, should such corporations be permitted to appropriate his patented combination by merely showing that they are using a more modern form of one of the elements in the patented combination?

2. Can a court limit the scope of an inventor's patent claim by reliance upon unproven handwritten notations appearing on the margin of certain pages of the Patent Office file, even though such notations form no part of the official Patent Office file, and notwithstanding the fact that the patentee had no knowledge of such notations?

3. Is the doctrine of file wrapper estoppel to limit a patent claim applicable when the court bases its decision upon a comparison of the allowed patent claim with an incomplete, inaccurate and misquoted claim, (apparently copied from respondent-defendant's brief) which is stated to have been rejected when in fact it was never before the Patent Office?

4. Where the trial court's finding of fact that the new combination produces an improved function or result is not shown to be clearly erroneous by the appellate court's decision, may such appellate court completely ignore such finding of fact and hold the patent invalid as not involving invention?

The Statute Involved

The Patent Statute is involved (Title 35, United States Code). Specifically, Section 103 provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case

There is no issue as to the ultimate controlling facts. The facts material to the consideration of this petition appear in the opinion of the Court of Appeals. The complaint (R. 8, 9) was filed by petitioner in the United States District Court for the Southern District of Texas, Houston Division, for infringement by respondent of claims 1, 3 and 6 of the Smith patent No. 2,765,373. Jurisdiction in the court of first instance was based upon the Patent Laws of the United States and United States Code, Title 28, Sections 1338 and 1400.

The District Court held the Smith patent valid and infringed. The Court of Appeals reversed.

Petitioner is an individual inventor. Respondent is a distributor selling hearing aid eyeglasses manufactured by Belton Hearing Aid Company, which is "in effect the real defendant" (Opinion, p. 3). Prior to petitioner's invention there were no hearing aid eyeglasses on the market and available to the hard-of-hearing public. While the patent was pending, petitioner disclosed his invention to several manufacturers, including Beltone, but the manufacturers showed no interest (R. 76,525). Later, however, Beltone as well as other manufacturers produced hearing aid eyeglasses involving the exact combination of the patent in suit.

The patent in suit appears in the record at pages 404-409 and relates to a combination hearing aid unit and eyeglasses wherein the operative components of a *complete* hearing aid unit are supported entirely within the side bow or templar member or members of the eyeglasses. This structure effectively separates the operative components

of such hearing aid unit from the front frame and lenses of the eyeglasses and produces the improved result or function of permitting the hearing aid specialist to fit and adjust the hearing aid without in any way involving the front frame or lenses, while at the same time allowing the optician to mount the lenses and fit the eyeglasses without disturbing the hearing aid unit.

The patent shows two main physical forms of the invention (Fig. 2, R. 404; Fig. 13, R. 405), and, although the patent claims can be read literally on both physical forms, the Court of Appeals interpreted the claims as readable upon only the attachment form (Fig. 13). The opinion reflects that the court based its decision upon unproven handwritten notations which appear on the margins of certain of the documents in the patent file. Such handwritten notations are quoted in the opinion on pages 11 and 14.

The opinion further reflects that the court applied the doctrine of file wrapper estoppel, and it based such estoppel upon a misquoted claim which the court stated to have been rejected by the Patent Office (Opinion, p. 13). Apparently, the court was led into the misquotation of the rejected claim by respondent's brief (p. 59) which presented the erroneous claim to the court. A comparison of the misquoted claim, upon which the court's decision is based, and the correct claim appears in Appendix E attached hereto.

The court's opinion further reveals that it completely ignored the lower court's finding of fact (F.F. IV, R. 384) that a new result or function is obtained by the patented combination and thereupon held the patent invalid for

lack of invention. This was a clear misapplication of the law as established by this Court in *Grinnell Washing Machine Co. v. Johnson Company* (1917), 247 U.S. 426, 38 S. Ct. 547, 62 L. Ed. 1196, and *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45, 43 S. Ct. 322, 67 L. Ed. 523, and *Webster Loom Co. v. Higgins*, 105 U.S. 580, 26 L. Ed. 1177.

Furthermore, the Court of Appeals erroneously gave credit for the invention to the use of more modern component parts used in *one element* of the patented combination, notwithstanding the fact that the patented combination was not present in the prior art, such holding being in such direct conflict with the applicable decisions of this Court as to call for an exercise of this Court's power of supervision.

Reasons for Granting the Writ

The petition should be granted because:

1. By basing its interpretation of the patent claims upon the unproven handwritten notations which appear in the Patent Office file history of the patent, the Court of Appeals has established an entirely new and unsound proposition of law that the file history of a patent is an exception to the hearsay evidence rule.

2. The limited interpretation given to the patent claim by the Court of Appeals and the court's conclusion that the doctrine of file wrapper estoppel is applicable were based on a misquoted incomplete claim which was never presented for consideration to the Patent Office.

3. In holding that the patented combination did not involve invention, the Court of Appeals completely ig-

noted the uncontradicted fact that the patented combination produced an entirely new function or result, which is contrary to the applicable decisions of this Court.

4. The Court of Appeals has decided, contrary to the applicable decisions of this Court, that the use of more modern components in one element of a combination is sufficient to destroy the combination claim.

Argument

The basic purpose of the patent statutes is to encourage invention by rewarding the individual inventor with a patent covering his contribution to the art, and such purpose is not served where, as here, the appellate court strikes the patent down in spite of the fact that petitioner has made a major advance which has benefited the hard-of-hearing public.

POINT 1:

The court's decision acknowledges that petitioner did something "differently" from the prior art (Opinion, p. 27). That something was to locate *all* of the operative components of the hearing aid unit (including not only the microphone but all other components of said unit) away from the front frame and lenses of the eyeglasses. This structure produces the necessary and essential function or result of permitting the aurist to fit and adjust the hearing aid unit without becoming involved in any way with the lenses or front frame of the eyeglasses and at the same time allowing the optician to mount the lenses and fit the eyeglasses without interfering with and

damaging any of the operative components of the hearing aid. Without this particular result or function, a combination hearing aid eyeglasses is not a practical or commercial unit.

Several physical forms of the invention are disclosed in the patent, and the court's opinion divides them into two categories:

1. Unitary type—illustrated in Fig. 2.
2. Hook-on type—illustrated in Fig. 13.

By reference to unproven, handwritten notations which appear on the margin of certain pages of the Patent Office file (R. 457*, 653) (Opinion, pp. 11 and 14), the court proceeded to the erroneous conclusion that the patent claims must be construed to cover only one physical form—the hook-on type of Fig. 13.

The court assumed that these unproven pencil notations were made by the Patent Office Examiner, but no proof was offered as to who made the notations, when they were made or for what reason they were made. Having been made by someone unknown to petitioner, petitioner had no knowledge of these notations; yet the court stated that "the circumstances impose a burden on Smith (petitioner here) or his attorneys to give some sort of explanation for the notations." The first notation* proves on

* The marginal notation appearing on the original, of which p. 457 of the record is a copy, did not reproduce in the record, but the notation written in pencil states "Decided (myself) patentable feature was detachable feature. Figures 12 and 13." It is unsigned and uninitialled.

its face that the writer thereof decided as to what in his opinion constituted a patentable feature without conveying his decision to anyone, since the notation clearly states "Decided (myself)." The second notation (R. 653) was made upon the margin of an *unentered* amendment which is *not a part of the official Patent Office file.*

That handwritten notations appearing in a patent file are *not* a part of such file is established by the Manual of Patent Examining Procedure, Section 1302.3, which requires that "All pencil notes made by the Examiners must be erased when the case is passed to issue." The reason for the requirement is to eliminate consideration of such "pencil notes" in interpreting the patent claims and to prevent a court from being misled, as was the case here, since it is within the province of the court, not the Patent Office, to interpret the patent after it is issued. Either the "pencil notes" were made after the patent issued or through inadvertence or for some other unknown reason, the requirement of Section 1302.3 of the Manual was not complied with, and the unproven handwritten notations were erroneously considered by the court.

The notations are pure hearsay, as was properly held by the District Court (R. 388).

The effect of the court's decision is to establish the unsound proposition that any handwritten unproven memorandum appearing in the file history of a United States patent is an exception to the hearsay rule and may be considered in interpreting the scope of the patent claim. Such a doctrine would throw open the door to fraud. The file history of a patent is a public record to which the public has free access. If the appellate court's

decision stands, anyone can obtain access to the file history of a patent and make *any desired handwritten* notation on the margins of its pages, whereupon the patentee would be under the burden of explaining it and being bound by it. The rule against hearsay evidence has been consistently enforced by the courts to prevent just this type of possible injustice.

Your petitioner submits that whether unproven notations appearing in the file history of a patent constitute an exception to the established hearsay evidence rule should be settled by this Court.

POINT 2

In its interpretation restricting the scope of the claims to a single physical form of the invention, the Court of Appeals applied the doctrine of file wrapper estoppel, which doctrine establishes that a patentee cannot construe an allowed claim in his patent to recapture what he gave up by cancellation of a rejected claim, *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 85 L. Ed. 132. Petitioner does not deny this doctrine but submits that the doctrine is not applicable here because the opinion shows on its face that the stated rejected claim (footnote 5, p. 13) was *never presented* to the Patent Office. The Court of Appeals identifies the quoted claim as rejected claim 31 which appears in the record, page 469. A comparison of the claims, as reproduced in Appendix E, establishes that there is a major difference in the actual rejected claim 31 and the claim set forth in the footnote.

As presented to the Patent Office, rejected claim 31 merely required that the air-conduction *receiver* of the

hearing aid be "mounted within and completely enclosed by one of said side templar members"; the microphone and amplifier assembly *were not restricted* to being within the templar member but were stated to be "located remotely from the front frame." By omitting the phrase concerning remote location of the microphone and amplifier, the court was misled into construing the "receiver" as a "hearing aid assembly" (Opinion, p. 14) and erroneously concluded that if "frame" as used in the claims defines the front lens frame, "there is no difference between claim 31 that was rejected and claim 32 (patent claim 1) that was allowed (Opinion, p. 17)."

The court was undoubtedly led into basing its decision on a misquoted claim since such claim was apparently copied from appellant-defendant's brief, where the erroneous claim first appears. Whatever the reason, the omission of the critical phrase resulted in the court's overlooking the fact that the rejected claim 31 and allowed claim 32 are vastly different at the *exact* point of novelty which carried the patentability of claim 32. The patent was granted by the Patent Office only when petitioner restricted the finally allowed claim to locating the *complete hearing assembly*, including *all* of its operative components, within the side templar member. This is the limitation which distinguishes petitioner's invention over the prior art; this is the limitation which is necessary to produce a practical combination eyeglasses hearing aid; and this is the limitation which defines respondent-defendant's structure. Petitioner has never attempted to recapture subject matter which he relinquished by reason of a cancelled claim.

It is submitted that there is no authority for basing an estoppel against proper interpretation of an allowed patent claim upon a misquoted erroneous claim which was never before the Patent Office.

POINT 3

The court's opinion relies upon *Grinnell Washing Machine Co. v. Johnson Co.*, 247 U.S. 426, 62 L.Ed. 1196, and *Hamilton Mfg. Co. v. Illinois Surgical Supply Co.* (7 Cir.), 193 F. 2d 938, in support of its conclusion that the patent is invalid. It is submitted that the law as established by these decisions has been misapplied.

The *Grinnell* case stands for the proposition that a combination of old elements is patentable if it produces a novel and useful result. The *Hamilton* case merely repeats the settled law that relocation of elements is not invention *unless* such relocation produces a *new result*.

Here, the patent in suit for the first time combined a hearing aid unit with eyeglasses in such a way that an *entirely new result*, not theretofore obtainable in hearing aid eyeglasses units, was produced. For the first time in the art, the aurist and the optician could each perform their specialized work, on the single combination unit, without interfering with each other. The trial court found as a fact (F.F. IV, R. 384) that the separation of aurist's and optician's functions made possible a commercially acceptable hearing aid eyeglasses.

The appellate court's opinion does not determine that the lower court's finding of a new result is "clearly erroneous" but rather completely ignores the same by stating that there is "very little evidence" to show that separating

the function of the optician from the function of the aurist "was ever an objective of the hearing aid industry." This statement is made in spite of the respondent-defendant's testimony that he was very careful not to fit the eyeglasses frame (R. 52), the manufacturer's bulletin cautioning all distributors against fitting eyeglasses (R. 497, 498) and the exhibit in the file history (R. 479) which shows that under certain state laws it would be impossible to sell hearing aid eyeglasses *unless* the function of the aurist and the function of the optician are properly separated.

The important question presented here, is whether an appellate court, without a showing that the trial court's finding that a *new result or function* has been achieved is clearly erroneous, can completely ignore such finding and hold, purely as a question of law, that no invention is present. It is respectfully submitted that this Court should settle this question.

Finally, the appellate court's opinion (p. 28) gives credit for the commercial success of hearing aid eyeglasses to the use of smaller size or more modern components in the hearing aid. Such components—transistors—were known prior to the patent in suit (Scaife patent No. 2,613,282, R. 627-633) and are merely part of one of the elements (the hearing aid) of the patented combination. No authority is cited by the court, and petitioner knows of no doctrine which supports a holding that a combination patent may be destroyed upon the ground that an infringer uses the most modern components available on the market in one element of the combination. That such doctrine does not exist should be finally settled by this Court.

Conclusion

For the foregoing reasons, it is urged that this petition for writ of certiorari be granted.

Respectfully submitted,

J. VINCENT MARTIN,

Counsel for Petitioner
Esperson Building
Houston, Texas

Of Counsel

VINSON, ELKINS, WEEMS
& SEARLS
JOE E. EDWARDS
M. H. GAY

October , 1959

Service of a copy of the above petition is acknowledged this day of October, 1959.

Attorney for Respondent

APPENDIX A

In The

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 17561

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,
Appellant,

versus

ALONZO L. SMITH,
Appellee.

Appeal from the United States District Court for the Southern District of Texas

---

(August 6, 1959)

Before HUTCHESON, Chief Judge, and BROWN and WISDOM, Circuit Judges.

WISDOM, Circuit Judge: The subject of this patent litigation is a hearing aid combined with eyeglasses.

Paul Glikin, doing business as Beltone Hearing Center in Houston, Texas, sold hearing aid eyeglasses in which an entire hearing aid was enclosed within one of the

sides (temple members or side bows) of a conventional pair of eyeglasses. Alonzo I. Smith, plaintiff-appellee, sued Glikin alleging infringement of claims 1, 3 and 6[1] of United States Patent No. 2,765,373, issued October 2, 1956, and entitled "Hearing Aid, Construction and Support therefor". Smith asked for an injunction, an accounting, and damages. Beltone Hearing Aid Com-

---

[1] The Smith patent contains six claims. Claims 2, 4, and 5 were withdrawn from the case. Claims 1, 3, and 6 read as follows:

"What is claimed is:

1. A self-contained hearing-aid structure for mounting to an eyeglasses frame, comprising side templar members adapted to be attached to the eyeglasses frame, at least one of said members having a hollow portion serving as a housing, a complete hearing-aid assembly including a microphone and an air-conduction receiver within said housing, means for mounting said side templar members to the eyeglasses frame to support the weight of the hearing-aid assembly on the said eyeglasses frame, and means on one of said side templar members extending into the ear of the user for conveying sound from the air-conduction receiver to the ear drum of the user. . . . 3. The combination with an eyeglasses-lens frame, of a wearable self-contained hearing aid structure for mounting to the eyeglasses frame, comprising a pair of side templar members adapted to be attached to the eyeglasses frame, at least one of said side templar members having a hollow portion serving as a housing, a complete hearing-aid assembly including a microphone and an air-conduction receiver within said housing, means for mounting the side templar members to the eyeglasses frame to distribute the weight of the hearing-aid assembly to the said eyeglasses frame, and means on one of said side templar members extending into the ear of the user for conveying sound from the air-conduction receiver to the ear drum of the user . . . . 6. A self-contained hearing-aid structure for mounting to an eyeglasses frame comprising, side templar members adapted to be attached to the eyeglasses frame, a complete hearing aid assembly including a microphone and an air-conduction receiver, means for supporting said complete hearing aid assembly in at least one of the side templar members, means for attaching said side templar members to the eyeglasses frame to support the weight of the hearing-aid assembly on the said eyeglasses frame, and means on one of said side templar members

pany, manufacturer of the defendant's hearing aid eyeglasses is in effect the real defendant. The district court found the patent valid and infringed. 163 F.Supp. 897. We reverse.

I.

Until recently, a conventional hearing aid consisted of a number of separate units: (1) a receiver placed in the ear, (2) a telltale wire from the receiver to the amplifier, and (3) an amplifier, batteries, and a microphone placed in the user's clothes. Such hearing aids were conspicuous; inconvenient, especially when the user dressed and undressed; and inefficient in that they picked up static from the rustle of clothing. To overcome these disadvantages, some of the prior workers combined an entire hearing aid with eyeglasses. Other prior workers, because of limitations imposed by the large size of necessary hearing aid components, placed some of the components in the frame (front lens frame and side bows), but placed the battery or power pack in a pocket or attached it to the user's clothes. Until the development of transistors, however, hearing aid components were too large for hearing aid eyeglasses to be practicable.

In 1952 and 1953 Raytheon's development of tiny transistors especially suitable for hearing aids quickly led to commercially successful and efficient hearing aid eyeglasses, first placed on the market in January, 1955.[2] By getting rid of large vacuum tubes and bulky

---

extending into the ear of the user for conveying sound from the air-conduction receiver to the ear drum of the user."

[2] A transistor is used as an amplifier, to amplify current, as an oscillator, and for other purposes for which vacuum tubes are ordinarily used. It is a three-element electronic device involving a semi-conductor as the basic element. The device consists of

batteries, and by substituting small components for equivalent large components, Beltone and others were able to enclose an entire hearing aid within one of the temple members of ordinary eyeglasses. Beltone credits the transistor developments of the Raytheon Company and the Bell Telephone Laboratories with making it possible to put miniature transistor circuits in the structures of Sargent, Bachmann, Scaife, and Cox, all of whom taught the idea of combining a hearing aid with a pair of glasses.

II.

Smith's eyeglasses, as illustrated in the drawings of the structures, show two different forms of hearing aid eyeglasses:

1) *The unitary type*, illustrated by Figure 2, in which the complete hearing aid is enclosed

---

three electrodes placed on a little chip or small block of germanium, with a base collector and emitter. In the point contact type of transistor, essentially a rectifier, the wires are placed in close proximity and depend on spring tension to make contact with the germanium. In the junction type transistor the wires are soldered, fused to a piece of germanium, two on each side, and are actually connected, through the emitter and base collector, to the charge.

A point contact transistor was known as early as 1948, but this type is not suitable for hearing aids because it produces too much noise to be tolerated in a hearing aid. The junction type fusion alloy type, transistor, especially designed for hearing aids was announced in 1952 and put on the market in 1953. Small as it was, this 1952 transistor was many times the size of the 1956 type transistor. The 1956 hearing aid transistor, exclusive of the small wires, was a cube a little less than one-eighth of an inch to the side.

In a hearing aid the transistor takes the place of a vacuum tube and also eliminates the need for a B battery and an output transformer. Because of the consequent reduction in the current (power) required, the size of batteries may be greatly reduced. Thus, a battery in a hearing aid is the size of a small

in one or both temple members of the eyeglasses, except for wires running through the front lens frame connecting the hearing aid assemblies;

2) *The hook-on type*, illustrated by Figure 13, in which the hearing aid assembly is enclosed in a separate housing provided with hooks by means of which it is "adapted to be attached" to the temple members of a conventional pair of eyeglasses.

The unitary type is an unconventional pair of eyeglasses in that, as described in the patent, the temple members "are rigidly secured to such [lens] frame"; that is, they are not hinged to the front lens frame but molded with the lens frame so that the eyeglasses constitute a single integral unit. The patent describes the hook-on type as "separate from the glasses so that it can be removed while reading or otherwise not needed while the glasses are kept on". The hook-on structure is not really a pair of hearing aid eyeglasses, but a hearing aid assembly to be mounted on eyeglasses.

The difference between the two physical forms, as illustrated in Figures 2 and 13, must be borne in mind since the defendant contends that the patentee's claims 1, 3 and 6—the claims in suit—do not cover, were not intended to cover, and cannot validly cover anything except the hook-on structure (Figure 13) "adapted to be attached" to a pair of conventional eyeglasses.

Smith argues that his invention lies in its novel combination: the location of the operative components of a hearing aid (microphone, amplifier, and receiver)

button, a little smaller in diameter than a dime and a little thinner than a nickle.

wholly within either one or both temple members, completely away and separate from the front frame or front lenses. In this proceeding (but not in his patent application, even as amended) Smith states that by dissociating the hearing aid components from the lenses, the eye specialist is able to perform his function of fitting and mounting the lenses and the ear specialist is able to perform his function without either interfering with the other. Smith argues that his combination was the first that had the practical advantage of separating these functions and it was this contribution to the hard of hearing that made hearing aid eyeglasses practicable and commercially successful.

III.

The history of the Patent Office prosecution is particularly important in this case because of the light it casts on the meaning, scope, and validity of the plaintiff's claims.

Smith filed his first application February 20, 1951, making broad claims (1) covering virtually any combination of a hearing aid and eyeglasses and (2) covering also a radio receiving set built into eyeglasses. There is not a word in the original application to suggest that Smith considered his invention resided in devising a combination separating the functions of ear specialist and eye specialist.[3] The Patent Office

[3] The application states: "The present invention relates to a hearing aid device and support therefor and more particularly day aid is made up of a number of units, comprising the aid. the user and which eliminates telltale outside cords. The present to a hearing aid and support which can be worn on the head of which are suspended or hung from various parts of the body: such as a button. receiver. tube. etc. placed in the ear. A wire or tube extends from the ear to the amplifier. batteries. and

rejected claims to both inventions, citing the Benway and Cox patents as authority for rejecting the hearing aid eyeglasses.

---

sometimes a microphone mounted in the clothes of the user. Conducting wires usually extend from all these parts, which make the aid very unhandy in use or in dressing. The present invention combines all these various parts into one unit which may be worn outside the clothing; eliminating the scattering of parts of wiring over the body. ¶ Most present day hearing aid devices are in a plurality of units, one of the major disadvantages of such hearing devices, both those which use the air conduction and bone conduction principle, is that a telltale cord or button which connects the parts together is always visible to the public. ¶ Not only is this visible cord or tube objectionable to the user of the hearing aid, but generally in all instances the user of the hearing aid dresses with the aid concealed in his clothing which is undesirable. ¶ One of the most objectionable features of the hearing aid is the static and noise set up by movement of the user's clothes transmitted to the user, thereby making it impossible to eliminate background or outside noise from the hearing aid. ¶ In attaching or removing a hearing aid of the present day construction, it is necessary for the user to partly undress in order to arrange the tube or cord from beneath the clothing. The present invention has therefore as one of its objects the provision of a hearing aid and support therefor which eliminates the use of visible tubes and wires and buttons and consists of a unitary device which may be placed in or out of use with no more effort or inconvenience than putting on or taking off ones glasses. ¶ Still another object of the invention is to provide a support for a hearing aid device, which support is in the form of a frame of the general type of spectacles or eye glasses and comprising a front frame portion to rest on the bridge of the nose and side bow portions connected to front frame portion and extending adjacent the side of the head and to the ears. ¶ Still another object of the invention is to provide a unitized hearing aid in one unit to eliminate external wires, receivers, buttons, microphones, batteries, etc. ¶ Another object of the invention is to provide a support for a hearing aid device, which support resembles or is in the form of spectacles or eye glasses frame comprising a front portion to rest on the front of the face and side bow portion connected to front frame portion and extending adjacent the side of the head and over the ears, there being spring means mounted in the support to resiliently urge said side bow portions inwardly against the side of the head. ¶ Still another object of the invention is to provide in combination eye glasses and a complete hearing aid device in-

June 24, 1952 Smith filed an amendment electing to prosecute claims to the hearing aid device and request-

---

cluding the lens, a microphone, amplifier, receiver, electrical energy power source, and electrical connections connecting each the microphone, amplifier, receiver, and power source. ¶ Still another object of the invention is to provide a hearing aid support which can be carried only on the head of the user of the hearing aid. ¶ A further object of the invention is to provide a device wearable on the head of the user t. receive wave impulses including means to intercept such impulses, means to amplify said impulses, means to receive such amplified impulses, and an electric power source, electric conductors connecting said power source with said intercepting means, amplifying means, and said receiver means, and a support for said device to fit on the head of the user. ¶ A further object of the invention is to provide a device wearable on the head of the user to receive wave impulses including means to intercept such impulses, means to amplify said impulses, means to receive such amplified impulses, and electric power source, electric conductors connecting said power source with said intercepting means, amplifying means, and said receiver means, and a support for said device to fit on the head of the user, said support comprising a front frame to engage the front of the head, and side bow portion connected to said front frame and extending along the side of the head and over the ear. ¶ Still another object of the invention is to provide a radio receiving set wearable on the head of the user and a support therefor comprising a radio frequency tuning inductance to receive a signal, means to amplify such signal, receiver means for converting such signal into sound waves, an electrical power source to supply energy to said amplifier, conductors connecting said amplifying means, tuning inductance and receiving means, and a support for said set including a front frame to engage the front of the head, and side bow portions extending along the side of the head and over the ears. ¶ Another object of the invention is to provide in combination with an air conduction hearing device for wearing on the head of a user, a support for such hearing aid device including a frame to rest on the front of the head of the user, side bow portions connected to said frame and extending along the side of the head of the user and over the ear, and spring means in said support for resiliently urging said side bows against the head of the user. ¶ Still another object of the invention is to provide in combination with a bone conduction hearing aid device for wearing on the head of the user, a support for such device comprising a frame to rest on the front of the head, side bow portions connected thereto and extending adjacent the head of the user and over the ears

ing allowance of Smith's claims over Cox, who had located the microphone in the lens frame. The Patent Office again rejected Smith's claims, this time citing Scaife along with Cox.[4] "The microphone", said the Examiner, "might be positioned in the side bow without involving invention".

July 6, 1953, in response to the rejection, Smith amended his application by cancelling claims 1-6 and 9-18, making verbal changes in claims 7 and 8, and adding claims 19-21. Still, as far as the language of the amended patent goes, Smith saw no connection between his invention and separation of the function of the hearing aid specialist from the eye specialist. He was of the opinion that "the invention in this application resides in the concept of a hearing aid device adapted to be positioned on the head of the user"; that is, a device not having separate parts distributed about the user's body. In answering the Examiner's objections based on Cox and Scaife, again Smith said nothing about the advantage, in fitting hearing aid glasses, of locating a microphone in the temple member instead of the front frame; instead, he attempted to distinguish the Cox and Scaife patents on the ground

---

[3] Another object of the invention is to provide a support for a unitary hearing aid for wearing on the head of a user. Still another object is to provide a hearing aid and support therefor for attaching to a pair of eye glasses."

[4] The Examiner wrote: "Claim 5 is rejected as being fully met by Cox, of record or Scaife, cited above. Claim 7 is rejected as being fully met by Cox, or record. Claims 12 and 13 are rejected as being unpatentable over Scaife, cited above. The microphone of Scaife might be positioned in the side bow without involving invention. Claims 12 and 13 are further rejected as being unpatentable over Cox, of record for reasons stated with reference to the Scaife patent. The batteries shown by Cox give the amplification. In early hearing aids only batteries were used. Certainly no invention could be involved in substituting

that they provided for bone conduction, not air conduction. That was the only distinction he saw between his structure and Scaife's.

March 11, 1954, the Patent Office rejected this amended application: "Cox states that his receiver may be either of the sound or bone conduction type. With regard to claim 8, Cox could be provided with an amplifier without involving invention. Scaife shows it to be old to provide such an amplifier".

Smith filed another amendment, September 1, 1954, rewriting claims 7 and 8 as new claims 22 and 23. Smith referred to the "two main advantages" of his invention as (1) "positioning" the frame on the head of the user in the conventional manner and (2) "preventing 'feed-back coupling' between the receiver and the microphone". In his answer to the Patent Office Smith reiterated that Scaife was concerned with a bone-conduction device, but he did add, without comment as to its relevancy in fitting eyeglasses, that the location of the Scaife microphone was in the central portion of the eyeglasses frame as opposed to the microphone's location in one of the side bows in the Smith device.

January 6, 1955 brought another amendment with additional claims. In the remarks accompanying the amendment, Smith pointed out that in his structure, unlike the structures of Hansel, Cox, and Scaife, the eyeglasses or spectacles frame does not necessarily form any part of the hearing aid device; the eyeglasses may be eliminated, as in Figure 13, or the eyeglasses may be connected to the hearing aid device, as shown in Figure 2. The new claims 24-26 bring out

---

new developments which are now old in the art, namely, an amplifier. "Claim 15 is rejected as being fully met by Scaife "Claim 18 is rejected as being fully met by Cox or Scaife."

that "the hearing aid device is adapted to be attached to an eyeglasses frame, with the side templar members having a space for positioning the air conduction receiver within one of such members". On this amendment is the Examiner's notation:

> "Decided (myself) patentable feature was detachable feature, Figures 12 and 13."

These are the hook-on structures which are are not an integral part of the eyeglasses.

August 24, 1955 Smith filed another amendment, cancelling claims 24-26 and substituting claims 27-30. In the accompanying remarks Smith listed six things he was the first to do. Sixth in the list was the claim that he was the first:

> "To make a self-contained hearing aid designed to resemble glasses but independent of the lens frame so that the hearing aid frame and mechanism can be fitted by a hearing aid specialist and the eyeglasses frame and the eyeglasses can be fitted by an optician or optometrist who are specialists in their field."

Claim 27 stated specifically that the side templar members contained a complete hearing aid but with no part of the aid formed with the eyeglasses lens frame, "whereby said lens frame can be fitted separately by an eyeglasses specialist and said hearing aid can be fitted separately by a hearing aid specialist". The Patent Office was unimpressed. Claims 27-30 were rejected on the basis of Scaife alone. It is quite clear that the Examiner considered that there would be no invention in separating the forward lens frame from

the side bows and mounting the microphone in one of the sides; only the hook-on device might be patentable:

> "Claims 19, 20, 22 and 23 are rejected as unpatentable over Scaife in view of the British patent and Cates. Scaife shows a hearing aid device mounted entirely within a spectacle frame. The British patent shows a sound emitting device depending from a spectacle side bow. There would be no invention in conducting the intelligence from the Scaife device to the wearer by means of a structure like that of the British patent or Cates. An ear mounted receiver, a bone conduction receiver, and an air tube are full patentable equivalents where no new or unusual result would be derived from a substitution of one for the other . . . . Claims 27-30 are rejected as unpatentable over Scaife taken alone. *There would be no invention in merely making the forward lens frame detachable from the bows and mounting the microphone in one of said bows.* The wires between the bows could simply be taped to the front frame and meet the terms of the claims. *If the structure of Figures 12 and 13 could be more clearly brought out, as decided in the interview, it is believed claims might be allowed thereon.*"

In response to the Patent Office action, Smith filed an amendment, March 13, 1956, in which he rewrote claims 27-30 as claims 31-34. This amendment deleted the reference to the alleged advantage of having a lens frame that could be fitted separately by an eyeglasses specialist and a hearing aid that could be fitted separately by a hearing aid specialist. In the remarks accompanying the amendment, however, Smith re-

peated his argument that "one of the most important contributions . . . resides in . . . keeping the optical functions and the hearing aid functions separate".

May 17, 1956, after an interview with Smith's attorneys, the Patent Examiner in an action termed "final rejection", rejected claim 31, and all previous claims, except claims 32, 33, and 34 (now claims 1, 2, and 3 of the patent in suit). We attach importance to the rejection of claim 31, especially in conjunction with allowance of claims 32, 33, and 34. Rejected claim 31 exactly describes the defendant's hearing aid eyeglasses. It exactly describes the eyeglasses plaintiff contends, *in this suit*, that he invented. But the hearing aid eyeglasses described in claim 31 differ radically from the structures described in patent claims 1, 3, and 6.[5] Precisely, with no room for ambiguity,

---

[5]

Rejected Claim 31	*Claim 32* *(later, Claim 1)*
A **wearable** hearing aid device adapted to be **worn** on the head of a user, comprising a front frame for the usual eye glasses lenses, two side templar members to support the front frame on the head of the user, an air-conduction receiver **mounted within and completely enclosed** by one of said side templar members so as to be hidden from view, a complete hearing aid microphone and amplifier assembly for conveying the output of the hearing aid assembly to said **receiver**, and means extending from said receiver into an ear of the user for conveying sound by air conduction from said **receiver** to the ear drum	A self-contained hearing aid structure for **mounting to an eyeglasses frame** comprising side templar members **adapted to be attached** to the eyeglasses frame at least one of said members having a hollow portion serving as a housing, a complete hearing aid assembly including a microphone and an air conduction receiver within said housing, **means for mounting** said side templar members to the eyeglasses frame to support the weight of the hearing aid assembly on the said eyeglasses frame, and means on one of said side templar members extending into the ear of the user for conveying sound from the air conduction receiver to the ear drum of the user"

claim 31 describes a "wearable" hearing aid device "adapted to be worn" comprising a front frame for the usual eyeglasses lenses with the hearing aid assembly "mounted *within and completely enclosed by* one of the side templar members". In patent claims 1, 3, and 6, however, the hearing aid is "a structure for *mounting to* an eyeglass frame", "side templar members *adapted to be attached to* the eyeglasses frame", with "*means for mounting* the side templar members *to* the eyeglasses frame".

Sometime after May 17, 1956 and before Smith filed his final amendment of August 15, 1956, a draft of the amendment was presented to the Patent Office, but not filed. A copy in the record has handwritten notations stating:

> "In this interview it was stressed that the claims allowed were to be construed to read on Figure 13."
>
> "And that the term eyeglass frame was intended to include the usual side bales or temple members."
>
> "Place in file for future clarification of terms of claims. R.R.S."

"R.R.S." are the initials of the Patent Examiner. No proof was offered as to who made the notations or when they were made and the patentee denied knowledge of the notations. The district court, in the opinion below, held that the notations were hearsay, that "no estoppel against Smith is created and he is not bound by these notations". The document, however,

is a draft of Smith's last amendment prepared by Smith's attorneys and bearing the signatures of these attorneys. Presumably, it has always been in the possession of the attorneys or the Examiner. The circumstances impose a bu den on Smith or his attorneys to give some sort of explanation for the notations. For what it is worth, and its worth is severely circumscribed by its manifest limitations, we think that the document is admissible.

The amendment of August 15, 1956, responsive to the final rejection of May 17, 1956, cancels the term "wearable" in the claim 32 and cancels claims 19 to 23 and 27 to 31. The amendment adds new claims 35, 36, and 37 described as necessary to give proper protection to the applicant. These new claims became claims 4, 5, and 6 of the patent.

As we see it, the Patent Office, consistently over five years, maintained that the location of a self-contained hearing aid within one or both temple members separate from the forward lens was not invention, relying particularly on the Cox and Scaife patents. Smith's invention, if any, according to the Patent Office, resided in a self-contained hearing aid structure, not "mounted within and completely enclosed by one of the side templar members" (Claim 31) but a structure to be mounted to the eyeglasses, by hooks or by other means.

The plaintiff argues that eyeglasses "frame" refers only to the frame surrounding the lenses. Thus, con-

tinues the plaintiff, the temple members of eyeglasses are "mounted" or "attached", within the meaning of his claims, particularly as illustrated in Figure 2 for the unitary type, when they are physically attached in any way to the forward lens frame. The defendant counters that "frame" includes side bows as well as the forward frame surrounding the lenses; that claims 1, 3, and 6 are applicable only to the hook-on attachable type, as illustrated in Figure 13.

There is no definition of frame, eyeglasses frame, or lens frame in the patent. The closest the patent comes to a definition, on which the plaintiff relies, is as follows:

> "Attention is directed to Fig. 2 of the drawing wherein the support is denominated generally by the numeral 2 and is shown as resembling or being constructed in the form of spectacles or eye glasses including the frame 3 adapted to rest on the front of the head of a user by means of the nose rest 4. Rigidly secured to such frame and extending rearwardly therefrom are the side bow portions 5 and 6."

This is the identical language that appeared in the original application of February 20, 1951, before changes were made in the claims in order to meet objections of the Patent Office. But this description of Figure 2 cannot be isolated and made controlling in disregard of the language of allowed claims completely different from the language of the original application. Thus, the 1956 Patent Office requirements that the structure be "mounted to" the frame, that it contain

"means for mounting", that it be "adapted to be attached to the eyeglasses frame", that "the means for mounting the side templar members to the eyeglasses frame to distribute the weight of the hearing aid assembly to said eyeglasses frame" are clearly inconsistent with the unitary type of eyeglasses (Figure 2) in which the whole frame (lens frame and side bows or frames) are molded into one piece. None of these limitations was in the original broad claims which were rejected and cancelled. If we go back to the original application, we find in claim 1 that Smith distinguishes between his two types of eyeglasses as having the hearing aid "made into" or "mounted on" the glasses; thus, Figure 2 illustrates a hearing aid made into glasses and Figure 13 a hearing aid mounted on eyeglasses. If, as the plaintiff argues, the quoted language limits the meaning of "frame" to the frame surrounding the lenses, there is no difference between claim 31 that was rejected and claim 32 (patent claim 1) that was allowed. The difference, however, is clear. Claim 31 describes the unitary type eyeglasses illustrated in Figure 2; claim 32 (patent claim 1) describes a "self-contained hearing aid structure for mounting to an eyeglasses frame". The term "means for mounting", as referred to in claim 2, are as follows:

> ". . . [M]ounting means includes releasable attaching members on the side templar members adapted to engage the eyeglasses frame."

Smith's unitary type eyeglasses contain wires through the front lens frame connecting the two temple members. It is difficult to see, therefore, how such a hear-

ing aid could be considered as independent of the front lens frame or as a self-contained structure for mounting even to the front lens frame.

Claim 3 refers to the "combination with an eyeglass lens frame of a wearable self-contained hearing aid structure for mounting to the eyeglasses frame". This can apply only to the Figure 13, the hook-on type which is a wearable self-contained structure capable of being mounted to eyeglasses. The hearing aid assembly in the Figure 2 construction is not wearable, and has no means for mounting; the temple members are an integral part of the eyeglasses, with nothing "adapted to be attached" to the one-piece construction.

Considering the history of Smith's patent applications, the consistent position of the Patent Office, the progressive modification of Smith's claims to meet the objections of the Patent Office, the language of the patent claims that were allowed, we conclude that the plaintiff's claims apply only to the attachable or hook-on type of hearing aid, for example, the structure illustrated in Figure 13, and to that extent they are invalid for lack of invention.

IV.

Our understanding of the Smith patent is supported by a review of the prior art. To the extent that Smith's claims go beyond a self-contained attachable hearing aid adapted to be mounted to eyeglasses, they are invalid for anticipation.

January 1, 1918, the Patent Office issues a patent to Sargent, No. 1,252,039, for a hearing aid combined with eyeglasses. This was a conical horn with a curved end designed to fit into the user's ear. As stated in the specification, this hearing aid "may be permanently worn with no particular inconvenience, and will greatly increase the ease of hearing of the wearer". The complete hearing aid was attached to each temple member of conventional eyeglasses, and was entirely independent of the other hearing aid. Each hearing aid was separate from the front of the frame, or lenses. Sargent employed an eartube and used air conduction as in Smith's device, but of course Sargent's device had no operative components such as are found in a modern hearing device. Although the hearing aid, because of the stage of electrical development in 1918, was mechanical rather than electrical, Sargent's idea of combining a hearing aid with eyeglasses and the idea of having the hearing aid parts dissociated from the front lens frame add up to what Smith calls his novel concept.

October 16, 1945, the Patent Office issued a design patent to Bachmann, No. 142,542, for a "Combined Hearing Aid Support and Spectacles". This patent shows conventional eyeglasses, including hinged temple members, but it neither shows nor describes its detailed structure. The Bachmann design patent shows hollow portions in each temple member for housing a hearing aid component; there is nothing in the front frame, even wires. Two months after Bachmann filed his ap-

plication for a design patent, he filed a mechanical patent application. This was rejected because of a lack of patentability. In this application a hearing aid was placed entirely within the temple member of the eyeglass frame, separate from the front of the frame; only the batteries, because of their large size at that time, were to be worn outside of the frame. The plaintiff argues that Bachmann abandoned his application; that it should not therefore be considered in the prior art. Bachmann however entered into a license agreement with the Sonotone corporation, a leading hearing aid manufacturer. It remained in effect for ten years, although 'er it no commercially successful hearing aid eyeglasses ere produced. *Alexander Milburn Co. v. Dans-Burnonville Co.*, 1926, 270 U.S. 390, 46 S.Ct. 324, 70 L.Ed. 651; 1 Walker on Patents, Deller's Ed., p. 279.

The Patent Office did not consider the Bachmann patent, but rejected Smith's claims 1 through 31 on the basis of a number of other patents. Two of these, Scaife and Cox, seem to us to have a clear application to Smith's contentions in this litigation.

The Scaife patent, No. 2,613,282, entitled "Spectacle Type Hearing Aid", issued on an application filed September 8, 1949, was frequently relied on by the Patent Office in its many rejections of Smith's claims. Scaife hearing aid eyeglasses have a completely self-contained hearing aid, partly within the hollowed out portion of one temple member and partly within the hollowed ou portion of the other side of the frame with connecting

wires." The microphone is between the two lenses. Smith's patent has every feature of the Scaife patent except the location of the microphone, both patents even showing interconnecting wires within the front frame of the eyeglasses. In Scaife the microphone is placed in the middle of the front lens frame, because Scaife considered it desirable to locate the microphone so as to receive sound vibrations from in front of the wearer's head; in Smith it is at the point where a temple member joins the front frame. The Patent Office showed scant respect for this difference between the Smith and Scaife devices. It advised Smith: "Claims 12 and 13 are rejected as being unpatentable over Scaife. The microphone of Scaife might be positioned in the side bow without involving invention". That is to say, a relocation of known elements creating no new result is not an invention.

The Cox patent, No. 2,207,705, was issued in 1936 for a combined hearing aid and eyeglasses. Cox discloses a self-contained hearing aid in which the amplifier, receiver, and power supplying batteries are placed within a single, conventional, hinged, temple member of the eyeglasses. The Cox patent states in part: "Briefly, the convenience of this invention is realized by having the ordinary lens of the eyeglasses [surrounded by car-

---

"Scaife states: 'While it is possible to embody the entire hearing aid within a support having the general configuration of a spectacle frame it may in some cases be desirable to mount the power unit separately from the frame while mounting the remainder of the hearing aid in the frame.' * * * 'Maximum advantage from the standpoint of inconspicuousness are obtained by mounting the entire mechanism within the support so that the hearing aid is entirely self-contained, no part of it is worn separately upon any portion of the body below the head and no conductors of electricity extend from the device."

bon granules] act as a pickup element or a diaphragm and combining the same with sound amplifying equipment into one unit. The sound reproducing mechanism is attached to or incorporated in the ear gripping portion of the temple of the eyeglasses. The battery used in connection with the microphone and sound reproducing mechanism is incorporated in a hollow portion of the frame of the eyeglasses." The Cox hearing aid and Beltone's hearing aid are better than Smith's in at least one respect, since the Cox and Beltone glasses do not have any wires or other hearing aid parts supported at the center of the front frame; if broken at the nose bridge a complete hearing aid would remain in the broken half of the eyeglasses.

It is undisputed that the concept of combining a hearing aid with eyeglasses, was old and well known long before Smith. It is also undisputed that the idea of putting some or all hearing aid components within or attached to eyeglasses was old and well known before Smith. Sargent and Bachmann both preceded Smith in disclosing a hearing aid carried by the temple members of a pair of eyeglasses, completely separated from the front lens and allowing a separation of functions between the eyeglasses specialist and hearing aid specialist. As a matter of fact it is only in the attachable or hook-on type of Smith's structure that there is a complete separation between temple members and lens frame, carrying a separation of function. In Bachmann the battery is not enclosed within the temple members but in Bachmann there are no hearing aid components in the front lens frame, whereas Smith has wires, a

material component, running through his front frame. The Cox patent provided for the battery to be placed inside or outside the side bow.

The Scaife and Cox structures are virtually identical with Smith's, except for their location of the microphone. Smith and Scaife have wires extending through the front frame connecting the hearing aid in one temple member with the hearing aid in the other temple member. In addition, both Smith and Scaife use rigid, nonfoldable, nonhinged temple members.

Smith's claim of invention, therefore, shakes down to relocation of the microphone. We agree with the Patent Office: "The microphone in Scaife might have been positioned in the side bow without involving invention."

V.

The patentee's claims, as he construes them in this case, are broad in scope and far-reaching in effect. A substantial segment of the hearing aid industry and an enormous number of the hard of hearing public will be affected if the patentee's contentions should be sustained in this litigation. In the circumstances, the interest of the public, paramount to the interest of the patentee and of the user of the accused device, compels a close scrutiny of the plaintiff's claim of invention.

A presumption of validity attaches to a patent. Because of this presumption and because a patent is a legislatively condoned monopoly that is not granted willy

nilly to just any advance or improvement in commerce, combination patents are viewed strictly.[7] This is particularly true where the elements in the combination are old and known to the art, since a liberal construction of such combination claims would erase the line,

---

[7] This philosophy has been consistently followed ever since Mr. Justice Bradley's classic opinion in Atlantic Works v. Brady, 1882, 107 U.S. 192, 2 S.Ct. 225, 27 L.Ed. 438, in which he observed:

> "The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

Other cases that draw from this philosophy are collected in Walker on Patents, vol. 1, § 27, page 139 (Deller's Ed. 1937).

In Bobertz v. General Motors Corp., 6 Cir., 1955, 228 F.2d 94, cert. den. 352 U.S. 824, the court said:

> "It seems almost idle to reiterate that quite a high standard of invention is now exacted to sustain combination claims embracing old elements in a patent. This fact was made plain fourteen years ago in the opinion of the Supreme Court in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 90-92, 62 S.Ct. 37, 86 L.Ed. 58. Any lingering doubt as to the intention of the Supreme Court to require strict rather than liberal construction of combination claims was certainly dispelled by its opinion in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 151, 71 S.Ct. 127, 95 L.Ed. 162, where the majority opinion concluded that the standard of invention used in the

such as it is, between mechanical judgment and inventive skill.

The patentability of a combination of elements is not determined solely by the result achieved. A "new and useful" result, as the cliche' goes, may be caused by nothing more than good mechanical judgment. Patentability must stand on some inventive faculty that is embodied in the manner in which the elements are combined—or fall with the lack of it. "A combination", the Supreme Court said in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 1908, 213 U.S. 301, 29 S.Ct. 495, 53 L.Ed. 805, "is a union of elements, which may be partly old and partly new, or wholly new. But whether new or old, the combination is a means—an invention—distinct from them." Commercial success, improvement, material contribution, novelty and the like are all evidence of invention. But these are not worth their salt if they are achieved by mechanical judgment only. That is the crux of virtually all combination patent cases. The benefits obtained from the combination are good indicia of invention. The vital question, however, in spite of the benefits, is always whether mechanical aptitude or inventive skill produced the benefits." *Robertson Rock Bit Co. v. Hughes Tool Co.*, 5 Cir., 1949, 176 F.2d 783.

Butex Gas Co. v. Southern Steel Co., 5 Cir., 1941, 123 F.2d 954 involved a combination patent for a unitary fitting in a butane gas distribution system. The combination brought together the necessary valves, gauges, and the other safety appliances in a single unit, eliminating the necessity of many separate units, just as the as-

lower courts was less exacting than that required where a combination was made up entirely of old components."

sembling of hearing aid components within an eyeglass frame eliminates separate units. Again, as in this case, all elements in the combination were old and known in the prior art. We held that the patent was invalid because the combination amounted to nothing more than a "different mechanical arrangement of elements producing no different result, but a mere aggregation, a monopolistic scope and wideness which in effect puts a roof over the whole butane gas industry".

In *Grinnell Washing Machine Co. v. Johnson Co.*, 1917, 247 U.S. 426, 38 S.Ct. 547, 62 L.Ed. 1196, the Patent Office granted a combination patent on a gearing device for use in operating power washing machines and wringers. The combination of old elements enabled the washing of a part of the clothes to be performed at the same time that the wringing process was being applied to other clothes. Thus, the combination, in effect, allowed two functions to operate separately. The Supreme Court struck down the patent, stating:

> "Generally speaking a combination of old elements, in order to be patentable must produce by their joint action a novel and useful result, or an old result in a more advantageous way . . . Applying the rule thus authoritatively settled by this Court, we think no invention is shown in assembling these old elements for the purposes declared. No new function is 'evolved from this combination;' the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements . . . From the cooperation of the elements here brought together, no new result, involving the exercise of the creative

> faculty which is invention is achieved. Phillips may have produced a more convenient and economical mechanism than others who preceded him but superiority does not make an aggregation patentable."

It is clear that Smith did not invent the idea of combining a hearing aid with eyeglasses; many others had done this long before. He did not invent the idea that hearing aids should be separate from the lenses; Sargent and Bachmann taught that. He did not invent the idea of enclosing hearing aid parts within the frame or side bows; the Scaife and Cox patents show hearing aids completely within the side bows and identical with Smith's unitary glasses, except for the location of the microphone. It is well settled that relocation of old elements is not invention. *Hamilton Mfg. Co. v. Illinois Surgical Supply Co.* 7 Cir., 1952, 193 F.2d 938. *Murray Company of Texas v. Continental Gin Company*, 5 Cir., 1959, —F.2d—. What Smith did differently from Scaife was to relocate a single known element, producing no new or unexpected result. This machanical rearrangement was well within the sphere of a skilled artisan or mechanic familiar with the prior art. It was not so novel, not such an addition to the sum of useful knowledge, as to rise to the dignity of an inventive contribution to the public entitling Smith to tax all users of eyeglasses in which the hearing aid is enclosed within a side bow of the structure."

"It is clear then that Brady did not invent the furnishing of vessels with water tanks, so arranged as to sink them on an even keel for these had been used long before in the light-draft monitors; he did not invent the use of revolving screws on a dredging boat, for cutting and stirring up mud and sediment, for those had been used for that purpose on the French steamers

VI.

There is very little evidence in the record to show that separating the function of the optician from the function of the aurist in fitting eyeglasses was ever an objective of the hearing aid industry. There is no evidence that such separation of function is responsible for the success of hearing aid glasses. There is considerable evidence however that the industry has constantly had before it the goal of devising practicable, small, inconspicuous, efficient hearing aids. The partial attainment of this goal through the development of transistors and other miniature components, not Smith's inventive genius, is responsbile for the acceptability and commercial success of hearing aid eyeglasses.

In this proceeding we see Smith as attempting to assert a patent monopoly over efficient and commercially successful hearing aid eyeglasses which owe their efficiency and success to scientific advances with which Smith had nothing to do.

---

and on The Enoch Train, in and prior to 1859; he did not invent the use of water tanks in a dredging-boat for sinking the screws down to the bottom or bar to be dredged, for this plant had been adopted in The Enoch Train; he did not invent the application of screws to the forward end of a dredge-boat, so as to work in advance of the boat, for this had been virtually done in The Enoch Train, and was formally done on the Wiggins Ferry; the plan of which had been invented by Bishop in 1858. What, then, did he invent? Did he make a selection and combination of these elements that would not have occurred to any ordinary skilled engineer, called upon, with all this previous knowledge and experience before him, to devise the construction of a strong dredge-boat for use at the mouth of the Mississippi? We think not. We think there is no reasonable ground for any such pretension." Atlantic Works v. Brady, 1882, 107 U.S. 192, 2 S.Ct. 225, 27 L.Ed. 438.

With all due deference to the able district judge, we feel compelled to hold that his decision was clearly erroneous. To the extent that Smith's claims go beyond a claim for an attachable or hook-on structure (an example of which is Figure 13 in the patent drawings) and are sought to be applied to hearing aid eyeglasses in which the hearing aid components are contained within the side bow (temple member or side frame) of eyeglasses they are invalid because of anticipation; and, to the extent that they claim for an attachable or hook-on structure, they are invalid for lack of invention.

REVERSED and RENDERED.

APPENDIX B

JUDGMENT.

Extract from the Minutes of August 6, 1959.

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,

No. 17561. versus

ALONZO L. SMITH,

This cause came on to be heard on the transscript of the record from the United States District Court for the Southern District of Texas, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed, and judgment is here rendered for appellant, Paul Glikin, d/b/a Beltone Hearing Center;

It is further ordered and adjudged that the appellee, Alonzo L. Smith, be condemned to pay the costs of this cause in this Court for which execution may be issued out of the said District Court.

APPENDIX C

500 OPINION OF THE COURT

(filed July 14, 1958)

(Caption Omitted)

This is a suit for patent infringement, injunction and accounting for profits and damages and assessment of costs brought by Alonzo I. Smith, plaintiff, against Paul Glikin, d/b/a Beltone Hearing Center, defendant. Plaintiff claims infringement of claims 1, 3 and 6 of the Smith Patent No. 2,765,373, issued October 2, 1956. Defendant denies infringement and takes the position that, if the claims are interpreted to be of sufficient scope to encompass defendant's structures, said claims are invalid in view of the prior art relied upon by defendant in this case.

This suit was instituted against the seller Glikin but the defense of such suit has been under the control of the Beltone Hearing Aid Company, manufacturer of the defendant's hearing aid eyglasses, so that the real defendant, in fact, is the Beltone Hearing Aid Company.

The patent in suit (Pl. 1) relates to a hearing aid eyeglasses and provides a structure wherein a complete hearing aid unit is housed in either one or both templar members of the structure so that the operative components of the hearing aid unit are completely independent of the lensframe and lenses of the eyeglasses.

Claims 1, 3 and 6 of the patent are directed to the particular combination in which the operative components of the complete hearing aid unit are mounted in at least one templar member of the hearing aid eyeglasses structure. These claims are of sufficient scope to cover the various physical forms which involve the novel combination.

The physical models of defendant's "Hear-N-See" and "Slimette" hearing aid eyeglasses are in evidence as plaintiff's Exhibits 6 and 7. These hearing aid eyeglasses are manufactured by Beltone Hearing Aid Company.

Defendant's hearing aid eyeglasses include a lens-frame having the lenses mounted therein with two templar members having their forward portions attached to the lense-frame. Within one of the side templar members, the defendant mounts a complete hearing aid. The defendant's device employs a hearing aid circuit which includes transistors but the claims in issue are not restricted to any particular circuit or to any specific hearing aid unit.

The evidence presented at the trial establishes that Smith was the first to provide the particular novel combination which locates the operative elements of the complete hearing aid unit in such position with respect to the lenses and lens-frame of the eyeglasses that said operative elements are, in effect, separate and independent from the lenses. The hearing aid unit may thus be fitted independently by the hearing aid specialist without affecting the lenses and the fitting of the lenses by the optician does not in any way affect the hearing aid unit. This important advantage, which stems from Smith's contribution to the art, made possible the construction of the first practical and commercially acceptable hearing aid eyeglasses.

No one, prior to the filing of the plaintiff's patent in suit, taught the particular combination defined by the claims of the patent. No prior worker recognized the importance or necessity of the operative elements of the complete hearing aid unit being entirely independent and separate of the lenses and lens-frame.

As to the Bachmann abandoned application (Def. Ex. 22), it cannot be relied upon as prior art because, being an abandoned application, it is not prior art. Walker on Patents, Deller's Edition, Vol. I, p. 279. Brown v. Guild; Brown v. Selby (corn-planter patent), 23 Wall (90 U.S.) 181, 211; 23 L. Ed. 161. Application of Schlittler, (CCPA 1956), 234 Fed. (2d) 883.

Even if the Bachmann abandoned application were admissible as prior art, the application itself refutes any contention that it discloses the particular combination of the Smith patent because the complete hearing aid is not contained in the templar member of the eyeglasses.

It is clear that patents involving new combinations are to be adjudged on determination of whether the combination is new, not on whether the elements which go to make up the combination are individually old in the art. Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U.S. 364, 367, 86 L. Ed. 1537, 1541; Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428, 443, 55 L. Ed. 527, 535; Leeds & Catlin Co. v. Victor Talking Mach. Co., 213 U.S. 325, 332, 53 L. Ed. 816, 819; Robertson Rock Bit Co. v. Hughes Tool Co., 176 Fed. (2d) 783, 790, 791; Bryan v. Sid W. Richardson, Inc., 117 PQ 157 (April 1958).

The most pertinent patents relied on by the defendant were before the Patent Office and were thoroughly considered before the Smith claims were allowed. Where the Patent Office has considered the most pertinent prior art, the presumption of validity, which attaches to a patent when issued, is greatly strengthened. That is the situation in this case. Southern States Equipment Corp. v. USCO Power Equipment Corp. (CA 5, 1953), 209 Fed. (2d) 111, 118.

Defendant attempts to jump the gap between validity and invalidity by dismissing what Smith has done as obvious. The question of whether or not a claimed combination is "obvious" must be determined in the light of all the surrounding facts and circumstances. Expanded Metal v. Bradford, 214 U.S. 366, 53 L. Ed. 1034; Sel-O-Rak Corporation v. The Henry Hanger & Display Fixture Corporation of America (CCA 5, 1956), 232 Fed. (2d) 176; Pointer v. Six Wheel Corporation (CCA 9, 1949), 177 Fed. (2d) 153, 160.

The authorities are clear that evaluation of the patent disclosure should not be viewed by hindsight. Diamond Rubber v. Consolidated Rubber, 220 U.S. 428, 434, 55 L. Ed. 527, 531.

The facts and circumstances of this case establish that the novel combination of the Smith patent was not obvious.

Defendant's whole theory upon which defendant's contention of non-infringement is based revolves about the term "eyeglasses frame" as used in the claims.

In order to determine what the term "eyeglasses frame" really means in the claims, it is only necessary to refer to the patent specification where the patentee clearly defines what is meant by that term. As the courts have held, a patent is its own dictionary and the patentee may define and designate the various elements of his invention in any desired manner. Nordberg v. Woolery (CA 7, 1935), 79 Fed. (2d) 685, 692.

The specification of the patent in suit makes it clear that the term "eyeglasses frame", as used in the patent, simply means the lens-frame which carries the lenses. Reference is made to column 3, lines 20 to 27.

In all claims, the only frame referred to is the eyeglasses frame or the eyeglasses-lens frame which can have only one meaning—the lens frame 3 in which the lenses are mounted.

Construing the claims 1, 3 and 6 in the light of the clear, unambiguous definition, both in the patent and in the Beltone manuals, of the term "frame" and considering the claims with respect to the clear meaning of their words, said claims 1, 3 and 6 are clearly infringed by defendant's structure.

Defendant contends that claims 1, 3 and 6 are not applicable to any of the physical forms of Smith's invention except Figure 13. Defendant's position in this respect is based upon the premise that the terms "eyeglasses frame" and "eyeglasses-lens frame", as used in the claims, mean a complete pair of eyeglasses including both the front lens frame and the side templar members. Claims 1, 3 and 6 are generic claims covering both physical forms of the same invention and when the terms "eyeglasses frame" and "eyeglasses-lens frame" are construed as they must be in the light of their clear meaning, said claims read squarely upon the physical form of Figure 2 and apply equally well to defendant's unit.

In a further attempt to limit the scope of the claims of the Smith patent, defendant contends that by reason of what transpired in the Patent Office, plaintiff is estopped to construe claims 1, 3 and 6 to cover any structure other than the so-called attachment type, shown in Figure 13. The doctrine of file wrapper estoppel is well recognized by the courts and is applied where a patentee, having been required to give up certain subject matter in order to obtain his patent, later attempt to construe the allowed claims to recapture that which he surrendered.

Plaintiff is not attempting to recapture any subject matter which was specifically given up during the prosecution of the application. Claims 1, 3 and 6 find response, exactly as worded, in the defendant's structure, and there is no attempt on plaintiff's part to enlarge the plain meaning of the words of the claims. New York Scaffolding Co. v. Whitney, 224 Fed. 452, 462 (CCA 8, 1915); Lawrence, et al. v. Hunt, et al., 142 Fed. Supp. 329 (aff. 242 Fed. (2d) 347; cert. denied 354 U.S. 910).

Defendant introduced Exhibit 34a for the purpose of relying upon certain pencil notations which appear at the upper portion of page 1 of the exhibit. No proofs have been offered as to who made these notations, why they were made or when they were made. Therefore, the pencil notations appearing on the exhibit are pure hearsay and are wholly inadmissible for any purpose. The patentee had no knowledge of the notations and did not agree or acquiesce to the truth thereof. Under such circumstances, no estoppel against the patentee Smith is created and he is not bound by them.

Furthermore, the unentered amendment Exhibit 34a was presented to the Patent Office after the allowance of claims 32 to 34 which became claims 1 to 3 of the patent. Therefore, the notations appearing on page 1 were obviously made subsequent to allowance of claims 1 to 3 and can, in no event, be considered to change the clear meaning of these claims. Diamond v. Ruby, 127 Fed. 341, 145, CC New Jersey, 1904.

During the trial, defendant presented evidence as to the commercial availability of transistors and contended that an eyeglasses hearing aid combination such as defined in the Smith patent could not be constructed without the use of transistors and other small parts. In substance, the

defendant is saying that because Smith elected to illustrate a well-known hearing aid circuit including vacuum tubes in his patent, said patent cannot cover equivalent elements used in the same way in the same combination because such equivalent elements are smaller.

Although transistors may not have been available on a large commercial scale, as they are today, they were in the public knowledge and were being used in industry. The Scaife patent 2,613,282, upon which defendant relies, refutes defendant's contention that transistors were not known at the time of filing of the Smith application because Scaife shows transistors in a hearing aid circuit.

Also defendant's witness Peters established that vacuum tubes and transistors are full equivalents, so far as function is concerned, in hearing aid amplifier circuits (R. p. 70; 309). The claims are not restricted to any particular type of hearing aid circuit and the substitution of one type of unit (the hearing aid transistor unit), for another type of unit (the hearing aid vacuum tube unit) where the elements are equivalent in a particular combination does not avoid infringement. Imhaeuser v. Buerk, 101 U.S. 647, 656. Southern Saw Service Co. v. Pittsburg-Erie Saw Corp. (5th Cir.), 239 Fed. (2d) 339.

I find plaintiff's patent valid and infringed and file the following as Findings of Fact and Conclusions of Law:

510 FINDINGS OF FACT

I.

Plaintiff is the owner of the entire right, title and interest in and to the A. L. Smith Patent No. 2,765,373, issued October 2, 1956, entitled "Hearing Aid, Construction and Support Therefor."

II.

Defendant is an individual and conducts his business under the name Beltone Hearing Center in Houston, Texas, and has sold, throughout the southern district of Texas, the hearing aid eyeglasses identified as the "Hear-N-See" model (Pl. Ex. 6) and the "Slimette" model (Pl. Ex. 7).

III.

The invention of the Smith patent discloses and claims a combination hearing aid eyeglasses in which all of the operative components of the complete hearing aid unit are mounted in either one or both templar members separate and independent from the lenses or the lens-frame of the eyeglasses.

IV.

The concept of the Smith patent provides the important practical advantage of permitting the hearing aid to be fitted to the user by the hearing aid specialist without interfering with the lenses of the eyeglasses and of also permitting the fitting of the lenses to be accomplished by the optician without in any way affecting the operative components of the hearing aid unit. It is this practical advantage which makes possible the construction of a commercially acceptable hearing aid eyeglasses.

V.

None of the disclosures of the prior patents and prior art relied upon by the defendant suggest or disclose a combination hearing aid eyeglasses in which all of the operative components of the complete hearing aid unit are mounted in either one or both templar members separate and independent from the lenses or the lens-frame of the

eyeglasses. Therefore, none of these disclosures have the practical advantage of permitting the hearing aid specialist and the optician to perform their respective functions without interfering with each other.

VI.

At the time that plaintiff filed the application for the Smith patent in suit, there were no hearing aid eyeglasses of any kind on the market and available to the public.

VII.

Plaintiff was not in the business of manufacturing hearing aids and after filing his applicatiin for the patent in suit, he attempted to interest various manufacturers in the invention but was unsuccessful. Thereafter, plaintiff decided to test the public acceptance of hearing glasses and, under the firm name of "Soundcraft", plaintiff promoted the sale of a type of hearing aid eyeglasses which, although not the structure of the patent in suit, was of a kind sufficient for plaintiff to determine whether or not the public would accept eyeglasses of a different appearance if they included the advantages of a hearing aid. This early type of hearing aid eyeglasses was the first hearing aid eyeglasses ever offered to the public by anyone and plaintiff was the pioneer in the promotion of the sale of hearing aid eyeglasses in the United States.

VIII.

The hearing aid eyeglasses sold by defendant are manufactured by the Beltone Hearing Aid Company of Chicago. The Beltone Hearing Aid Company became aware of plaintiff's activity with respect to his early type of hearing aid eyeglasses and actually assisted plaintiff in the pro-

motion of the sale thereof. At that time the Beltone Hearing Aid Company was not manufacturing hearing aid eyeglasses of any type. Through correspondence with plaintiff, the Beltone Hearing Aid Company received a complete disclosure from plaintiff in November, 1954, of the subject matter of the patent in suit. About 15 months later Beltone Hearing Aid Company announced to the public its manufacture of one form of the hearing aid eyeglasses which are charged to be an infringement of the patent in suit. The interest of the Beltone Hearing Aid Company in hearing aid eyeglasses was initiated by plaintiff's disclosure to it of the subject matter of the patent in suit in November, 1954.

IX.

Transistors were known at the time that the patent in suit was filed and the particular transistor preferred in modern hearing aid units has been available since the fall of 1952. Even though these transistors were readily available to the hearing aid industry since 1952, no manufacturer produced a hearing aid eyeglasses until 1955 which was after plaintiff had fully disclosed his new combination to the industry in November, 1954.

X.

The acceptability and commercial success of hearing aid eyeglasses is dependent upon the new combination disclosed in the Smith patent and is not dependent upon the size of the component parts of the hearing aid unit. Although smaller component parts naturally permit a smaller hearing aid unit to be constructed, the basis of Smith's advance in the art is not in the size of my component of the *hearing aid unit but resides in the particular combination which*

locates all of the operative components of the hearing aid unit away from the lenses and lens-frame of the eyeglasses.

XI.

The patent in suit illustrates a hearing aid circuit which includes vacuum tubes while the defendant's accused structure employs a hearing aid circuit employing transistors. The circuit employing transistors functions in the same way as the circuit employing vacuum tubes and one is the full equivalent of the other. Claims 1, 3 and 6 of the patent in suit do not define any particular type of hearing aid circuit and cover both tube and transistor type circuits.

XII.

Throughout the prosecution of the patent in suit in the Patent Office, plaintiff persistently and continuously contended that claims 1, 3 and 6 of the patent were directed to the particular combination in which the operative components of the hearing aid unit were mounted in one or both templar members and that said claims encompass the various physical forms of this combination as illustrated in the drawings and specification of the patent. Plaintiff never at any time acquiesced or agreed that the scope of the claims and particularly claims 1, 3 and 6 were limited to any one physical form or embodiment. The doctrine of file wrapper estoppel is not applicable under these circumstances to limit the construction of claims 1, 3 and 6 to the specific embodiment of the Smith invention illustrated in Figure 13 of the drawings.

XIII.

During the prosecution of the patent in suit in the Patent Office, the Patent Office considered the most perti-

nent prior art and allowed the claims of the patent over such art.

XIV.

The terms "eyeglasses frame" and "eyeglasses lens-frame" as used in claims 1, 3 and 6, are clearly defined in the patent specification as meaning the lens-frame and these terms, as used in the claims, do not include the templar members or side bow portions.

XV.

The proposed amendment (Pl. Ex. 34a) was never filed with the Patent Office as a part of the record of the patent in suit; not being a part of the file history of the Smith patent, this unfiled amendment cannot affect the interpretation to be given claims 1, 3 and 6 of the Smith patent. The handwritten notations on page 1 of this proposed amendment are hearsay and are not admissible for any purpose.

XVI.

The language of claims 1, 3 and 6 is clear and unambiguous. The elements called for by claims 1, 3 and 6 are present in the "Hear-N-See" and "Slimette" models of hearing aid eyeglasses sold by the defendant Glikin and manufactured by the Beltone Hearing Aid Company and claims 1, 3 and 6 are infringed.

XVII.

The Beltone Hearing Aid Company, manufacturer of the defendant's hearing aid eyeglasses, assumed the defense of this suit, the evidence showing that Beltone selected counsel for the defense, financed the litigation and controlled the same in all respects.

517 CONCLUSIONS OF LAW

I.

This court has jurisdiction of the parties and of all issues raised by the pleadings in this action.

II.

Plaintiff has the right, title and interest in and to the Smith patent No. 2,765,373.

III.

Consideration of the best prior art by the Patent Office during the prosecution of the application from which the Smith patent matured strengthens the presumption of validity of said Smith patent.

IV.

The prior art cited by defendant does not anticipate claims 1, 3 and 6 of the Smith patent No. 2,765,373.

V.

The Bachmann abandoned application (Defendant's Ex. 2) is not prior art against the Smith patent.

VI.

The proposed unfiled amendment (Defendant's Ex. 34a) is not a part of the file history of the Smith patent No. 2,765,373 and cannot be considered in construing the claims of the patent as finally allowed.

VII.

Claims 1, 3 and 6 of the Smith patent No. 2,765,373 are valid as directed to a new combination.

VIII.

The clear unambiguous language of claims 1, 3 and 6 is applicable to the defendant's "Hear-N-See" and the "Slimette" models manufactured by Beltone Hearing Aid Company and sold by defendant and claims 1, 3 and 6 of the Smith patent are infringed by these structures.

Counsel will draft and submit decree accordingly.

JOE INGRAHAM
Judge

APPENDIX D

520 FINAL JUDGMENT

(filed July 30, 1958)

(Caption Omitted)

This cause came on to be tried before the Court sitting without a jury, and the Court having considered the pleadings and evidence presented on trial and upon briefs submitted for the respective parties; and the Court having heretofore made and filed its Opinion and Findings of Fact and Conclusions of Law, it is hereby

ORDERED, ADJUDGED and DECREED

1.

That Plaintiff herein has title to United States Letters Patent No. 2,765,373 issued October 2, 1956 to Alonzo L. Smith.

2.

That claims 1, 3 and 6 of said United States Letters Patent No. 2,765,373 are valid.

3.

That the Defendant, Paul Glikin, d/b/a Beltone Hearing Center has infringed claims 1, 3 and 6 of said patent No. 2,765,373 by selling the Beltone hearing aid glasses identified as "Hear-N-See" and "Slimette" (Pl. Ex. 6 and 7) within the Southern District of Texas.

4.

That a writ of injunction issue out of and under the seal of this Court directed to the said Paul Glikin, his

agents, attorneys, employees, associates and privies, enjoining them and each of them from directly or indirectly infringing claims 1, 3 and 6 of said United States Letters Patent No. 2,765,373 during the remainder of the term for which said patent has been granted.

5.

That Plaintiff recover from Defendant the damages to which he is entitled by law.

6.

That this case be referred to a special master to take and state an account of Plaintiff's damages and to assess the same by reason of said infringement.

7.

That the Plaintiff recover from Defendant his costs in this suit to be taxed by the Clerk.

Dated this 30th day of July, 1958.

/s/ JOE INGRAHAM
United States District Judge

Approved as to form:
JOE E. EDWARDS
Attorney for Plaintiff

GARRETT R. TUCKER, JR.
Attorney for Defendant

APPENDIX E

Claim 31 as considered by the Court and quoted in footnote on page 13 of Opinion

A wearable hearing aid device adapted to be worn on the head of a user, comprising a front frame for the usual eyeglasses lenses, two side templar members to support the front frame on the head of the user, an air-conduction receiver mounted within and completely enclosed by one of said side templar members so as to be hidden from view, a complete hearing aid microphone and amplifier assembly for conveying the output of the hearing-aid assembly to said receiver, and means extending from said receiver into an ear of the user for conveying sound by air conduction from said receiver to the ear drum.

Claim 31 as presented to the Patent Office Record, page 469

A wearable hearing-aid device adapted to be worn on the head of a user, comprising a front frame for the usual eyeglasses lenses, two side templar members to support the front frame on the head of the user, an air-conduction receiver mounted within and completely enclosed in one of said side templar members so as to be hidden from view, a complete hearing aid microphone and amplifier assembly to coact with the receiver and located remotely from the front frame, means extending from the hearing aid microphone and amplifier assembly for conveying the output of the hearing aid assembly to said receiver, and means extending from said receiver into an ear of the user for conveying sound by air conduction from said receiver to the ear drum.

FILE COPY

FILED
NOV 14 1959
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 493

ALONZO L. SMITH,

Petitioner,

v.

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,

Respondent.

BRIEF FOR RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI

WILL FREEMAN
135 South LaSalle Street
Chicago 3, Illinois
Counsel for Respondent

Of Counsel:
GARRETT R. TUCKER, JR.
FRANK B. PUGSLEY
Esperson Building
Houston, Texas
and
SHELDON W. WITCOFF
135 South LaSalle Street
Chicago 3, Illinois

CHICAGO LAW PRINTING CORP., 139 W. MADISON, CHICAGO FR anklin 2-4521

SUBJECT INDEX.

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Summary Statement of the Case	2
Argument for Denying the Petition for Writ of Certiorari	5
Answering Point 1	5
Answering Point 2	7
Answering Point 3	8
Conclusion	8

List of Authorities.

Grinnell Washing Machine Co. v. Johnson Company (1917) 247 U.S. 426, 38 S. Ct. 547, 62 L. Ed. 1196.... 6, 8

Hamilton Mfg. Co. v. Illinois Surgical Supply Co. (7 Cir.) 193 F. 2d 938 ..... 6, 8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 493

ALONZO L. SMITH,

Petitioner,

v.

PAUL GLIKIN, d/b/a BELTONE HEARING CENTER,

Respondent.

BRIEF FOR RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI

To The Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent, Paul Glikin, submits this Brief in opposition to the Petition for Writ of Certiorari.

Respondent asserts that the Petition presents no ground which justifies the Writ.

OPINIONS BELOW

The Opinion of the Court of Appeals for the Fifth Circuit holding Petitioner's United States Patent No. 2,765,373 "invalid because of anticipation" and "invalid for lack of invention" is reported at 269 F. 2d 641.

The Opinion of the District Court is reported at 163 F. Supp. 897.

JURISDICTION.

The jurisdictional requisites are set forth in the Petition.

QUESTIONS PRESENTED.

Petitioner sets forth four questions upon which review is sought. These questions are merely ancillary to the real basis for the Court of Appeals' holding of invalidity because of anticipation and for lack of invention. The only proper question presented by the Petition is summed up as follows:

Where, in a patent infringement suit between two private litigants, the Court of Appeals holds the patent invalid because of anticipation by the prior art and invalid for lack of invention over the prior art—and there is no conflict of decision or unsettled question of Federal law—should the Supreme Court exercise its certiorari jurisdiction?

Respondent submits that the answer to this question clearly should be—NO—.

SUMMARY STATEMENT OF THE CASE.

Petitioner brought suit charging Respondent with infringement of Smith Patent No. 2,765,373. This patent relates to eyeglasses supported hearing aids. The Court of Appeals for the Fifth Circuit unanimously held the patent claims in issue invalid because of anticipation, and invalid for lack of invention. No other lawsuit has been filed involving this patent, and accordingly there is no conflict of decision.

The four questions presented by Petitioner are really unimportant to the controlling issue of patent validity as decided by the Court below. Petitioner, in the Court be-

low, asserted his invention to be the placing of an entire hearing aid within a temple member of a pair of eyeglasses. The documentary evidence in this case clearly showed that the combination of eyeglasses and hearing aids is old and well known in the prior art. Petitioner's questions do not relate to the documentary evidence as to the facts upon which the Court of Appeals relied in holding the patent invalid regardless of its scope. It is clear that the Court below relied on the prior art in reaching its decision that the Smith patent was invalid because of anticipation and for lack of invention. In addition, it was shown that nowhere within the four corners of the Smith patent was there any disclosure of a complete hearing aid within a temple member, the very combination over which Petitioner was attempting to assert a patent monopoly.

The following quoted portions from the Court of Appeals' Opinion set forth a clear cut statement of this case and of the Court's basis for holding the Smith patent invalid:

> "It is clear that Smith did not invent the idea of combining a hearing aid with eyeglasses; many others had done this long before. He did not invent the idea that hearing aids should be separate from the lenses; Sargent and Bachmann taught that. He did not invent the idea of enclosing hearing aid parts within the frame or side bows; the Scaife and Cox patents show hearing aids completely within the side bows and identical with Smith's unitary glasses, except for the location of the microphone. It is well settled that relocation of old elements is not invention." . . . (Opinion, page 27)

> "What Smith did differently from Scaife was to relocate a single known element, producing no new or unexpected result. This mechanical rearrangement was well within the sphere of a skilled artisan or mechanic familiar with the prior art. It was not so novel,

not such an addition to the sum of useful knowledge, as to rise to the dignity of an inventive contribution to the public entitling Smith to tax all users of eyeglasses in which the hearing aid is enclosed within a side bow of the structure." . . . (Opinion, page 27)

"There is considerable evidence however that the industry has constantly had before it the goal of devising practicable, small, inconspicuous, efficient hearing aids. The partial attainment of this goal through the development of transistors and other miniature components, not Smith's inventive genius, is responsible for the acceptability and commercial success of hearing aid eyeglasses." (Opinion, page 28)

"In this proceeding we see Smith as attempting to assert a patent monopoly over efficient and commercially successful hearing aid eyeglasses which owe their efficiency and success to scientific advances with which Smith had nothing to do." (Opinion, page 28)

"With all due deference to the able district judge, we feel compelled to hold that his decision was clearly erroneous. To the extent that Smith's claims go beyond a claim for an attachable or hook-on structure (an example of which is Figure 13 in the patent drawings) and are sought to be applied to hearing aid eyeglasses in which the hearing aid components are contained within the side bow (temple member or side frame) of eyeglasses they are invalid because of anticipation; and, to the extent that they claim for an attachable or hook-on structure, they are invalid for lack of invention." (Opinion, page 29)

These unequivocal statements by the Court of Appeals—based upon documentary evidence—are more than ample to point out the total lack of substance in Petitioner's claim of invention.

The points raised by Petitioner in his "Statement of the Case" relate to mere ancillary matters which do not touch upon the merits of the case and which, therefore, do not affect the Court's holding of invalidity because of anticipation and for lack of invention.

ARGUMENT FOR DENYING THE PETITION FOR WRIT OF CERTIORARI.

In his Statement of the Case, Petitioner asserts that—"There is no issue as to the ultimate controlling facts." Respondent does not fully understand this assertion. If Petitioner accepts what we and the Court of Appeals consider to be the "ultimate controlling facts", namely—that the Smith patent is invalid because of anticipation by prior art and for lack of invention—then there is no issue for this Court to consider. Petitioner concedes that the facts material to the consideration of its Petition are found in the Opinion of the Court of Appeals (Petition, page 4). Respondent does not believe that this Court should be concerned with retrying the issues of validity and infringement when bottomed on documentary evidence, as in this case—particularly when Petitioner has failed to show any conflict of decision or any unsettled question of Federal law.

Answering Point 1.

In Point 1 of his argument, Petitioner states that what he did "differently" from the prior art was to locate all of the operative components of a hearing aid unit away from the front lens frame of a pair of eyeglasses. In answer, Respondent calls the Court's attention to the following:

1. Petitioner repeatedly asserted this position before the Court of Appeals.
2. The Court of Appeals met this assertion directly and held that all Smith did "differently from Scaife (a prior art patent) was to relocate a single known element, producing no new or unexpected result" (Opinion, page 27).
3. Even the Patent Office had something to say as to this relocation—"The microphone of Scaife might be positioned in the side bow without involving invention" (R., page 442).

Petitioner's Point 2 is immaterial and irrelevant to the question of validity over the prior art of claims actually within the patent. Respondent submits that this is not a significant, important or a proper material matter to assert—for the first time in this case—in a Petition for Writ of Certiorari.

Answering Point 3.

Petitioner's Point 3 is equally without merit in that it challenges the settled doctrine that mere relocation of one element of a combination without providing a new result is not invention.

Petitioner's alleged contribution amounted to nothing more than changing the microphone from one position to another in an old combination of eyeglasses and hearing aid. The Court of Appeals held that no new or unexpected result was produced (Opinion, page 27), and therefore, the Court agreed with the Patent Office that such a change did not involve invention over the prior art (Opinion, page 23).

The Court of Appeals' decision is directly in accord with the principles laid down in the cases of *Grinnell Washing Machine Co.* v. *Johnson Co.*, and *Hamilton Mfg. Co.* v. *Illinois Surgical Supply Co.*, cited *supra*. A correct decision on a narrow and simple issue grounded on well-settled principles of law does not require the further consideration of this Court.

CONCLUSION.

Respondent finds no conflict of decision or important question of Federal law raised in the Petition which requires decision by this Court. The Petition is notably lacking in any frontal attack on the Court of Appeals'

holding of invalidity because of anticipation and for lack of invention. No material ground has been presented justifying granting of the Writ of Certiorari. The Petition is without merit, in fact or in law, and should be denied.

Respectfully submitted,

WILL FREEMAN

.....

Counsel for Respondent
135 South LaSalle Street
Chicago 3, Illinois

Of Counsel:
GARRETT R. TUCKER, JR.
FRANK B. PUGSLEY
Esperson Building
Houston, Texas
and
SHELDON W. WITCOFF
135 South LaSalle Street
Chicago 3, Illinois

November 12, 1959

Certificate of Service.

A copy of the foregoing Brief was deposited in the United States mail in an envelope properly stamped, and air mailed postage prepaid addressed to Mr. J. Vincent Martin, Counsel for Petitioner, this ..... day of November, 1959.

.....

Counsel for Respondent

LE COPY

FILED
NOV
JAMES R. BROWNING, Cler

IN THE

Supreme Court of the United States

October Term, 1959

No. 493

ALONZO L. SMITH, *Petitioner*

v.

PAUL GILKIN, d/b/a BELTONE HEARING CENTER,
Respondent

PETITIONER'S REPLY TO RESPONDENT'S BRIEF

VINSON, ELKINS, WEEMS
& SEARLS
JOE E. EDWARDS
M. H. GAY
Of Counsel

J. VINCENT MARTIN,
Counsel for Petitioner
Esperson Building
Houston, Texas

Alpha Law Brief Co., 402 M & M Bldg., Houston 2

IN THE

Supreme Court of the United States

October Term, 1959

No. 493

ALONZO L. SMITH, *Petitioner*

v.

PAUL GILKIN, d/b/a BELTONE HEARING CENTER,
Respondent

PETITIONER'S REPLY TO RESPONDENT'S BRIEF

Respondent's brief does not squarely meet the real issues presented by the Petition but instead follows a pattern which obscures and confuses those issues.

As to Petitioner's Point 1.

Respondent does not deny that the Court below did consider the unproven handwritten notations in its interpretation of the patent claims and does not dispute Petitioner's position that such action by the Court establishes the novel and unsound proposition that a patent file history is an exception to the hearsay evidence rule.

With reference to the prior patent to Scaife, Respondent quotes from the file history (brief p. 5, paragraph numbered 3). But Respondent very carefully avoids mentioning that the quoted statement referring to relocation was made by the Patent Office in rejecting, not the patent claims, but claims 12 and 13 (R. p. 426-427) which were much broader in scope and which were not even directed to hearing aid eyeglasses.

It is not unusual—in fact it is the rule rather than the exception—that early in the prosecution of a patent application broad claims are presented and rejected. However, when the patentee defines the invention in more specific terms, the Patent Office withdraws the previous rejection and allows the more specific claim. This is exactly the happening here.

As to Petitioner's Point 2.

Respondent admits, as he must, that the limited interpretation given the claims here by the Court was based on a misquoted incomplete claim which was never before the Patent Office.

Finding that the Court was led into error because he misquoted the claim in his brief, Respondent complains that Petitioner raises this error for the first time. The Court's error did not appear until its opinion was written so that Petitioner had no reason to complain until the opinion was rendered. Respondent takes the position that because Petitioner did not discover Respondent's error earlier, there is some type of estoppel or limitation against Petitioner raising the question now. Petitioner knows of no such rule and there is none.

As to Petitioner's Point 3.

Respondent erroneously urges that Petitioner "challenges the settled doctrine that mere relocation of one element of a combination without providing a new result is not invention." (Brief, p. 8) Petitioner does not challenge such doctrine.

What Petitioner has challenged here is the appellate Court's error in ignoring the uncontradicted finding of fact of the District Court that a new result or function is produced by the combination of the patent in suit. The Court did not hold that such finding of fact was clearly erroneous and not supported by the evidence but rather ignored the same which led the Court into a misapplication of the settled law with respect to relocation of parts.

The Petition for Writ of Certiorari should be granted.

Respectfully submitted,

J. VINCENT MARTIN
Counsel for Petitioner
Esperson Building
Houston, Texas

Of Counsel:
VINSON, ELKINS, WEEMS
& SEARLS
JOE E. EDWARDS
M. H. GAY

November , 1959

Service of a copy of the above Petitioner's Reply to Respondent's Brief is acknowledged this day of November, 1959.

Attorney for Respondent